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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/755,644	01/06/2001	Alfred D. Roeske		4900

23535 7590 03/28/2003

MEDLEN & CARROLL, LLP
101 HOWARD STREET
SUITE 350
SAN FRANCISCO, CA 94105

EXAMINER

TOOMER, CEPHIA D

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 03/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/755,644

Applicant(s)

ROESKE ET AL.

Examiner

Cephia D. Toomer

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— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 22, 2003 has been entered.
2. This Office action is in response to the amendment wherein claims 1 and 9 were amended.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
4. Claims 1-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tao (US 6,284,007) in view of Sinwald (US 5,753,015) and TI-food.

Tao teaches a vegetable lipid - based composition and candle comprising fully hydrogenated triglycerides and free fatty acids and paraffin wax (see col., lines 50-59; col. 2, lines 49-64). The free fatty acid and triglycerides are preferably saturated (see

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col. 3, lines 1-2). The composition contains a free fatty acid/triglyceride mixture in a ratio from 1-99% triglyceride and from 1 to 99% fatty acid (see Example 5).

Tao also teaches compositions wherein no fatty acid is present (Example 1).

Tao teaches the limitations of the claims other than the differences that are discussed below.

In the first aspect, Tao differs from the claims in that he does not specifically teach the claimed IV. However, it would be reasonable to expect that the triglycerides of Tao would possess the claimed IV because Tao teaches that the oils are fully hydrogenated and Sinwald and Tl-foo d teach that fully hydrogenated vegetable oils have IV from 10 to perhaps as low as 0 (see Sinwald, col. 1-3; Tl-food, type PV and SS fully hydrogenated oils). It should be noted that in certain circumstances, references cited to show a universal fact need not be available as prior art before applicant's filing date, as in the instant case, Tl-food. Such facts include the characteristics and properties of a material or a scientific truism, or that characteristics of prior art products were known, *In re Wilson*, 311 F.2d 266, 135 USPQ 442 (CCPA 1962). *In re Koller*, 613 F.2d 819, 823 n.5, 204 USPQ 702, 706 n.5 (CCPA 1980) (quoting *In re Hogan*, 559 F.2d 595, 605 n.17, 194 USPQ 527, 537 n.17 (CCPA 1977) (emphasis in original)).

In the second aspect, Tao differs from the claims in that he does not specifically teach all of the claimed proportions of triglyceride, paraffin and stearic acid. However, it is not inventive to determine these result effective variables through routine experimentation. This would especially hold true since Tao is not limited to the amount of the paraffin and triglyceride/fatty acid mixture that is present in the composition.

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Furthermore, Tao's preferred embodiment establishes a *prima facie* case of obviousness because a *prima facie* case of obviousness exist where the claimed ranges and the prior art ranges do not overlap but are close enough that one skilled in the art would have expected them to have the same properties. *Titanium Metals v. Banner*, 227 USPQ 773 (Fed. Cir. 1985).

5. Applicant's arguments filed have been fully considered but they are not persuasive.

6. Applicant argues that Ta teaches up to about 49% by weight of the petroleum wax and that it was improper to reject claims 10, 11 and 18 since these claims recite a paraffin content in excess of 50%.

Tao does teach in one of his preferred embodiments that up to 49% by weight of wax may be present in the composition (see col. 1, lines 60-67). However, as shown by claim1, Tao is not limited to this amount of petroleum wax.

7. Applicant argues that Tao does not teach, suggest or mention that the fatty material of his invention is hydrogenated to the point wherein the material would possess the claim IV, nor does Tao recognize that the fatty materials possessing the claimed IV create candles that are substantially non-sooting. Applicant argues that Tao is only concerned about producing a candle that is solid at the temperature at which the candle is burned and that Tao did not understand the importance of using fully hydrogenated materials.

Tao teaches that the triglycerides of his invention are fully hydrogenated vegetable oils and Sinwald and TI-food teach that fully hydrogenated vegetable oils

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have an IV from 10 to perhaps as low as 0. Tl-foods' teaching of IV value of 2 max is interpreted as 2 and those values less than 2. Therefore, since Tao teaches triglycerides that possess the claimed IV and are within the scope of the present invention, the candles of Tao would also be substantially non-sooting. Furthermore, Tao recognizes that candles that produce soot increase human health risk by production of carcinogens. Therefore, one of Tao's objectives is to produce a candle wherein the production of soot is minimized upon burning the candle (see col. 1, lines 23-48).

While Tao states that soot and smoke were observed while the candles were burned, Tao also states that the amount of soot and smoke was lower than that of a paraffin candle. Applicant's claims state that the formation of soot is substantially prevented, but not completely prevented. Tao states that the soot and smoke formation was subjectively judged.

Applicant's data also appears to be subjective since the determination of soot formation is based upon a visual test wherein the final determination of test is based upon the initial whiteness of the handkerchief and the perception of the observer.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cephia D. Toomer whose telephone number is 703-308-2509. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 703-306-2777. The fax phone numbers for the organization where this application or proceeding is assigned are 703-

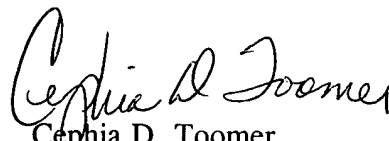
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872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Cephia D. Toomer
Primary Examiner
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March 24, 2003